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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,242	10/25/2005	Shigeru Yamago	2005-1665A	6569

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EXAMINER	
BERNSHTEYN, MICHAEL	

ART UNIT	PAPER NUMBER
1796	

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10/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/554,242	YAMAGO ET AL.	
	Examiner	Art Unit	
	Michael M. Bernshteyn	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is a response to the remarks filed on March 16, 2007. Claims 1 and 2 have been amended; no claims have been cancelled or added.

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 12, 2007 has been entered.

3. Claims 1-3 are now pending.

Claim Rejections - 35 USC § 103

4. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.

5. Claims 1-3 are rejected under 35 U.S.C. §103(a) as being unpatentable as obvious over Yamago et al. ("Tailored Synthesis of Structurally Defined polymers by Organotellurium-Mediated Living Radical Polymerization", Journal of American Chemical Society, 2002, 124, 13666-13667) in view of Alger ("Polymer Science Dictionary", 2nd Edition", Chapman & Hall, 1997), for the rationale recited in paragraph 2 of Office Action dated on September 18, 2006.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1 and 2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 7,291,690 in view of Alger ("Polymer Science Dictionary", 2nd Edition", Chapman & Hall, 1997). Although the conflicting claims are not identical, they are not patently distinct from each other because the process for producing a living radical polymer which comprises an organotellurium compound of formula (1) and ditellurium of formula (2) described in claims 1 and 6 of US'690 is substantially identical to the process for producing a living radical polymer which comprises an organotellurium compound of formula (1) and ditellurium of formula (2) and an azo type polymerization initiator described in claims 1 and 2 of the current application.

Alger discloses that azo initiator is well known type of initiator for the polymerization. Azobisbutyronitrile is by far the commonest example, others include azobiscyclohexylnitrile and 2,2'-azobis-2,4-dimethylvaleronitrile, etc. (page 35). These initiators are widely used as free radical polymerization initiators especially for styrene, vinyl chloride, etc. (pages 34-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate azo type polymerization initiator as taught by Alger in Yamago's polymerization process with new organotellurium-based initiators with reasonable expectation of success, because "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." ***In re Kerkhoven,*** 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted) (Claims to a process of preparing a spray-dried detergent by mixing together two conventional spray-dried detergents were held to be *prima facie* obvious.). See also ***In re Crockett***, 279 F.2d 274, 126 USPQ 186 (CCPA 1960) (Claims directed to a method and material for treating cast iron using a mixture comprising calcium carbide and magnesium oxide were held unpatentable over prior art disclosures that the aforementioned components individually promote the formation of a nodular structure in cast iron.); and *Ex parte Quadranti*, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992) (mixture of two known herbicides held prima facie obvious).

Claim Rejections - 35 USC § 102

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 7,291,690.

The applied reference has a common assignee and inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Response to Arguments

8. Applicants traverse the rejection under 35 U.S.C. § 103(a) of claims 1-3 as being unpatentable over Yamago et al. in view of Alger. Applicant's arguments have been fully considered but they are not persuasive.

9. In the response to the Applicants arguments that the amended claims 1 and 2 having a molecular weight distribution of 1.05 to 1.50 can now overcome the rejection under U.S.C. § 103(a) (page 4, the last paragraph), it is noted that Applicant has not demonstrated that the differences, if any, between the claimed process for producing a living radical polymer give rise to unexpected results. The evidence presented to rebut *prima facie* case of obviousness must be commensurate in scope with the claims to which it pertains. See ***In re Dill and Scales***, 202 USPQ 805 (CCPA 1979).

Claim 1 recites " polymerizing a vinyl monomer in the presence of an organotellurium compound represented by formula (1) , an azo type polymerization initiator and a detulliride compound represented by formula (2)". Therefore, according to claim 1, any vinyl monomer being polymerized with these three compounds gives the molecular weight distribution within the claimed ranges. It is definetely not commensurate in scope with the claims. Additionally, any azo initiator and any ditelluride compound can be used for this purpose.

With regard to the Applicants argument concerning the limitations for the molecular weight distribution, it is noted that the prior art of Yamago clearly discloses that the molecular weight distribution is within the claimed range for all entries of Table 1 (page 13666).

10. Therefore, the rejection under 35 U.S.C. 103(a) cannot be withdrawn and remains in force.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael M. Bernshteyn
Patent Examiner
Art Unit 1796

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10/22/2007

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